

REMARKS

Claims 1, 2, 4-14, and 16-26 and 43- 46 are pending in this application. Claims 27-42 have been canceled without prejudice to or disclaimer of the subject matter therein. Claims 1, 2, 4-14, 16-26 and 43-46 stand rejected. Favorable reconsideration is respectfully requested in view of the following remarks.

Double Patenting

In response to the Examiner's remarks on double patenting, claims 27-42 have been canceled.

Claim rejections

Section 103

Claims 1, 4-13 and 16-26 have been rejected under 35 USC 103(a) as being unpatentable over Kaneko et al. (US 6,383,678) (hereafter, "Kaneko") in view of Cullity, Elements of X-ray Diffraction, 2nd edition (hereafter, "Cullity").

However, Kaneko is disqualified as prior art under section 103 because Kaneko only qualifies as prior art under 35 USC 102(e), and the subject matter of Kaneko and the claimed invention were, at the time the claimed invention was made, owned by or subject to an obligation of assignment to Toyota Jidosha Kabushiki Kaisha, a corporation of Japan. See 35 USC 103(c). As evidence thereof, the clear and conspicuous statement below is provided by the undersigned attorney of record in the present application (see MPEP 706.02(I)(2)(II)):

STATEMENT OF COMMON OWNERSHIP

Application 09/837,480 and Patent 6,383,678 B1 were, at the time the invention of application 09/837,480 was made, owned by or subject to an obligation of assignment to Toyota Jidosha Kabushiki Kaisha, a corporation of Japan.

In view of the above, Kaneko cannot be applied under section 103 to reject claims 1, 4-13 and 16-26, and Cullity does not independently render claims 1, 4-13 and 16-26 obvious. Accordingly, withdrawal of the rejection of claims 1, 4-13 and 16-26 as being unpatentable over Kaneko in view of Cullity is respectfully requested.

Claims 1, 2, 4, 13, 14, 16, 25, 26, 42 and 45 were rejected under 35 USC 103(a) as being unpatentable over Hwang et al. (US 6,090, 228) (hereafter, "Hwang") in view of Cullity. Claim 42 has been canceled above. For purposes of responsiveness, the Applicant assumes that the Examiner means claim 43, not claim 42.

The Applicant respectfully traverses the asserted rejection. The cited references do not support the rejection for at least the reason that, even in combination, the references do not suggest "a metal coating layer ... formed at least on [a] surface of [a] separator base material ... wherein the metal coating layer comprises crystal grains having an average grain size of 0.1 mm or more," as recited in independent claims 1 and 13.

The Examiner acknowledges that the foregoing disclosure is absent from Hwang, but cites Cullity as providing the disclosure. The Applicant respectfully disagrees. It is noted that to be validly applied under section 103, a reference must be (1) within the inventor's field of endeavor, or if not, (2) reasonably pertinent to the particular problem with which the inventor was involved. See, e.g., *In re Clay*, 966 F.2d 656, 23 USPQ2d (Fed. Cir. 1992). Here, neither of criteria (1) or (2) is met by Cullity. Cullity only discusses grain sizes of "commercial metals and alloys" in general, and only in the context of measuring the grain sizes by X-ray diffraction. Cullity shows no recognition of problem faced by the present inventors and contains no mention of a coating layer on a surface of a separator base material, as required by the claims.

In view of the above, claims 1 and 13 are allowable over Hwang and Cullity. Further, since they incorporate the features of one of the independent claims, the dependent claims are likewise allowable over Hwang and Cullity for at least the reasons discussed in connection with the independent claims. Withdrawal of the rejection of

claims 1, 2, 4, 13, 14, 16, 25, 26, 43 and 45 as unpatentable over Hwang and Cullity is therefore respectfully requested.

Claim objections

Claims 44 and 46 were objected to as being dependent on rejected base claims. In view of the foregoing discussion, claims 2 and 14 on which claims 44 and 46 respectively depend are allowable. Withdrawal of the objection is therefore respectfully requested.

Conclusion

In light of the above discussion, Applicant respectfully submits that the present application is in all aspects in allowable condition, and earnestly solicits favorable reconsideration and early issuance of a Notice of Allowance.

The Examiner is invited to contact the undersigned at (202) 220-4323 to discuss any matter concerning this application. The Office is authorized to charge any fees related to this communication to Deposit Account No. 11-0600.

Respectfully submitted,

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